



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0496-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
)
Marie-Pascale AUDOUSSET) Group Art Unit: 1751
)
Application No.: 09/443,505) Examiner: M. Einsmann
)
CPA Filed: February 27, 2003)
)
For: COMPOSITION FOR THE)
OXIDATION DYEING OF KERATIN)
FIBRES AND DYEING PROCESS)
USING THIS COMPOSITION)

Mail Stop Appeal Brief--Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellant submits this Reply Brief to the Board of Patent Appeals and Interferences in response to the September 21, 2004, Examiner's Answer, in the above-identified application. If any additional fees are required or if the enclosed payment is insufficient, Appellant requests that the required fees be charged to Deposit Account No. 06-0916.

I. Response to Examiner's Answer

Claims 1-3 and 5-18 stand rejected under 35 U.S.C. § 103(a) over (1) U.S. Patent No. 6,074,438 to Lim et al. ("*Lim*") in view of U.S. Patent No. 5,230,710 and Akram et al. ("*Akram*") and (2) *Lim* in view of *Akram* and further in view of U.S. Patent No. 4,997,451 to Clausen et al. ("*Clausen*"). Appellant maintains the positions of record regarding these rejections, and add the additional arguments set forth below in response to statements made in the Examiner's Answer.

A. *Lim* in view of *Akram*

1. The Examiner Improperly Substitutes "Suitability" for Evidence of a Motivation to Make the Claimed Invention

The mere fact that *Lim* includes certain of the claimed ingredients in the same illustrative list does not provide evidence of a motivation to make the claimed invention. But the Office contends otherwise. Indeed, in the Examiner's Answer, the Office maintains that *Lim* "suggests the combination as claimed as he teaches that both of the components in the claimed compositions are suitable for use together" Examiner's Answer, page 6; *Lim*, col. 6, lines 7-11 ("Illustrative component dye ingredients . . . that can be considered suitable for use in the compositions . . . are set forth below."). The Office concludes, therefore, that *Lim* alone provides a sufficient teaching to make the claimed invention. Examiner's Answer, page 7.

Appellant respectfully disagrees with this conclusion as *Lim* provides no specific guidance to make the dye composition presently claimed. *Teleflex Inc. v. Ficosa North Am. Corp.*, 299 F.3d 1313, 1334, 63 USPQ2d 1374, 1387 (Fed. Cir. 2002) (requiring a "clear and particular" suggestion to combine or modify prior art references). Appellant submits that the broad generic disclosure of "illustrative component dye ingredients"

does not direct one skilled in the art to the claimed combination. Rather, one skilled in the art must first decide to pick a specific genus from the five different genera of primary intermediates and couplers disclosed in *Lim*. *Lim*, cols. 5-7. Then, one must decide to chose a specific species of p-aminophenol derivatives and a specific species of phenol and resorcinol derivatives from within the genera disclosed. Both of these derivatives fall within genera that are *broadly described* in *Lim* - making the odds of selecting the claimed components slim.

By randomly picking and choosing, it is possible that the claimed combination of an oxidation base and coupler *could* result; however, the specification gives no apparent direction, let alone a "clear and particular" suggestion as required by law, for making this combination. *Teleflex*, 299 F.3d at 1334, 63 USPQ2d at 1387. In fact, *Lim* fails to provide guidance for selecting the claimed combination of at least one oxidation base and coupler over any of the other possible combinations that could result. When one skilled in the art has to pick and choose among a wide range of variables in a cited reference to construct a claim, obviousness cannot be demonstrated. *In re Fine*, 837 F.2d 1071, 1075, 112 USPQ 320, 1600 (Fed. Cir. 1988)("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art").

In attempt to limit the breadth of *Lim*'s disclosure, the Office maintains that *Akram* narrows the possible combinations because it provides a particular motivation to select 2,6-bis(hydroxyethylamino)toluene from the list of couplers disclosed in *Lim*. Examiner's Answer, page 7. Appellant respectfully submits that *Akram* provides no suggestion, even taken together with *Lim*, to make the claimed combination. When a combination invention can only be arrived at by combining various components

described in separate prior art references, there must be some reason for the combination, i.e., a teaching or an incentive. M.P.E.P. § 2145 (X)(C). No such reason exists here. There is no suggestion in the prior art, besides a passing reference to “suitability”, to select a particular component from each of the references, while excluding certain others, to arrive at the claimed invention. When *Lim* and *Akram* are viewed as a whole, nothing in either reference recognizes the desirability of producing the claimed *combination*.

In sum, the Office has merely established that the claimed invention would have been obvious to try, which is not the standard required by law. In explaining such an analysis, the Federal Circuit has commented that “what would have been ‘obvious to try’ would have been to vary all parameters and try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.” *In re O’Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673,1681 (Fed. Cir. 1988). The latter scenario describes the present rejection - neither *Lim* nor *Akram* provide sufficient direction to make the claimed combinations. Accordingly, for at least the reasons discussed above, Appellant respectfully requests that the Board reverse and withdraw this improper rejection.

2. The Examiner’s Obviousness Position is an Exercise of Hindsight

Central to an obviousness position is the process of “casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.” *In re Kotzab*, 217 F.3d 1365, 1368, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citations

omitted). Here, instead of being guided by the prior art and the knowledge of one skilled in the art, the Office is led by the Appellant's own specification. This is improper.

To disguise its use of hindsight, the Office quotes, for example, to case law that stands for the proposition that the prior art can be relied on "for all that it teaches" and "for all that it would have reasonably suggested." Examiner's Answer, page 8. While Appellant agrees with the holdings of these cases, Appellant respectfully disagrees with the Office's application of it to the present facts. Although *Lim* and *Akram* can and should be relied on "for all that [they teach]," a disclosure of specific species of oxidation bases and a specific coupler in a specification that encompasses many different sorts of dye components does not add up to a teaching of the two ingredients together. Rather, a reliance on these references for all that they teach merely results in an extensive list of possible combinations. A suggestion to take a certain action, however, must consist of more than the co-existence of two ingredients in a single document. Indeed, as Appellant has already explained in the Appeal Brief, "[i]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *Kotzab*, 217 F.3d at 1370, 55 USPQ2d at 1316. Accordingly, for at least this additional reason, Appellant respectfully requests that the Office reverse and withdraw this improper rejection.

B. *Lim* in view of *Akram* and further in view of *Claussen*

1. *Claussen* provides no suggestion for the use of substituted p-aminophenols as a class.

The Office improperly relies on "equivalence" as a short-cut means for satisfying its burden of establishing its obviousness case. Specifically, the Office alleges that "Claussen shows that the claimed [oxidation] bases are well known, the color and depth

of color of each [oxidation] base has been studied and catalogued, and they are *equivalent* for use in oxidative hair coloring systems.” Examiner’s Answer, page 9 (emphasis added). Simply put, the Office asserts that all substituted p-aminophenols are interchangeable and it is prima facie obvious to substitute one for the other. But the law simply does not support this assertion. To the contrary, the law demands that the Examiner point to specific teachings that would have motivated one skilled in the art to modify the references to arrive at the claimed invention rather than simply stating that the claimed invention is obvious in view of a bare assertion of “equivalence.”

As Appellant laid out in the Appeal Brief, the *Claussen* reference provides no support for the proposition that substituted p-aminophenols are equivalent. In fact, *Claussen* suggests otherwise. For example, *Claussen* notes that structurally similar substituted p-aminophenols, such as the presently claimed 4-amino-3-methylphenol results in “considerably reduced color depth” than their claimed 4-aminophenol derivatives. *Claussen*, lines 60-63; see also Appeal Brief, pages 14-15. This demonstrates that these oxidation bases are not, in fact, “equivalent” as the Office alleges as each provide different dying results.

Moreover, case law also does not support the proposition that a legal conclusion of obviousness under 35 U.S.C. § 103(a) can be based solely on “equivalence”. *In re Scott*, 139 USPQ 297 (CCPA 1963). Indeed, the predecessor to the Court of Appeals for the Federal Circuit held as much in *In re Scott*. In this case, the Court stated, “[t]he examiner and the board appear to hold that the mere existence of functional and mechanical equivalence establishes obviousness. We think this involves a non-sequitur. Expedients which are functionally equivalent to each other are not necessarily

obvious *in view of* one another.” *Id.* at 299. This holding is directly applicable here - simply because substituted p-aminophenols can function as oxidative bases does not necessarily mean that all species in this genus are obvious in view of one another. Accordingly, for at least this reason, Appellant respectfully requests that the Board reverse and withdraw this improper rejection.

2. The Office Ignores the Significance of the Examples Disclosed in the Present Specification

Examples 3 and 4 in the present specification support the proposition that one skilled in the art would not have had a reasonable expectation of success in creating the claimed invention. The Office dismisses this argument, however, by stating that the Examples are not persuasive because they are not commensurate in scope with the claimed invention and are not a comparison with the closest prior art. Examiner’s Answer, page 9. This argument misses the point. Appellant drew the Board’s attention to Examples 3 and 4 of the present specification to illustrate that the Office had provided no evidence showing a reasonable expectation of success in making the claimed combination. The present invention, by the comparative examples, provide a graphic illustration of the unpredictability in the hair dye art.

Specifically, the present invention discloses that, in Example 3, for instance, when p-aminophenol, which is not within the scope of the present invention but is disclosed by both *Lim* and *Claussen*, is used as an oxidation base in combination with the claimed coupler, the resulting coloration is less fast than that obtained when an oxidation base, which is within the scope of the present invention, is used in combination with the same claimed coupler. Therefore, the comparative test result disclosed in the present application clearly indicates that not every oxidation base,

especially not all p-aminophenols disclosed in *Lim* can be reasonably expected to achieve successful results when combined with the claimed coupler.

As a result, the Examiner's proposed combination is merely conjecture. There is simply no evidence that there would have been a reasonable expectation of success in obtaining a hair dye as claimed by combining the cited references. Accordingly, for at least this additional reason, Appellant respectfully requests that the Board reverse and withdraw this improper rejection.

III. Conclusion

For the reasons set forth above, Appellant maintains that a prima facie case of obviousness has not been established by the combination of cited references.

Appellant maintains the position on all issues covered by the Appeal Brief filed on July 1, 2004. Thus, Appellant respectfully requests reversal of all the rejections of claims 1-3 and 5-18 under 35 U.S.C. § 103(a).

If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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